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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,563	09/12/2000	Gregory L. Slaughter	5181-64900	6903
58467	7590	06/02/2010		
MHKKG/Oracle (Sun)			EXAMINER	
P.O. BOX 398			CHANKONG, DOHM	
AUSTIN, TX 78767				
			ART UNIT	PAPER NUMBER
			2452	
			NOTIFICATION DATE	DELIVERY MODE
			06/02/2010 ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

09/660,563

Applicant(s)

SLAUGHTER ET AL.

Examiner

DOHM CHANKONG

Art Unit

2452

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This non-final action is in response to Applicant's amendment filed on 2/9/2010. Applicant amends claims 1, 11, 21-23, and 28-30. Claims 1-30 are presented for further examination.

I. CLAIM REJECTIONS - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

A. Claims 21-30 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Applicant's amendment to the computer-readable storage medium of claims 21-30 is insufficient to overcome the § 101 rejection set forth by the Board in its decision on 9/14/2009. The current position of the Patent Office is that any computer-readable medium (CRM) that may read on both statutory and non-statutory embodiments must be rejected under § 101.

Applicant's specification controls the interpretation of the CRM. If there is an explicit definition in the specification, that definition will control the interpretation. Where, however, the specification merely gives *examples*, e.g., a computer-readable medium may be or includes hard disk, ROM, RAM, then the term is given its broadest reasonable interpretation consistent with the specification.

Claims 21-30 recite a computer-readable storage medium storing program instructions. Applicant's specification discloses that storage media may be "magnetic or optical media, e.g.,

disk or CD-ROM.” Since there is no explicit definition for storage media in the specification, the term is given its reasonable broadest meaning .

The current position of the Patent Office is that transmission media or wires may still be interpreted as storage media since they “store” transmissions as they transmit them. The Office suggests amending the claim to recite “non-transitory” computer readable storage medium to overcome this interpretation and the § 101 rejection.

II. CLAIM REJECTIONS - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

A. Claims 1-5, 7-15, 17-25, and 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Beck et al. (U.S. Patent Number 6,604,140), hereinafter referred to as Beck.

Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a system or a carrier medium are rejected under the same rationale applied to the described claim.

Claims 1, 11, and 21

Beck discloses a method comprising: a client reading an advertisement from a space, wherein the space comprises a network-addressable storage location (column 6, lines 1-16), wherein the advertisement comprises a Uniform Resource Identifier (URI) and a schema,

wherein the URI specifies a network address at which a service may be accessed, and wherein the schema specifies one or more messages usable to invoke one or more functions of the service (column 4, lines 40-60); and the client sending a first message to the service at the URI, wherein the first message is specified in the schema (column 6, lines 30-39).

Claims 2, 12, and 22

The method of claim 1, further comprising: the service sending a second message to the client in response to the client sending the first message to the service, wherein the second message is specified in the schema (column 6, lines 41-44).

Claims 3, 13, and 23

The method of claim 1, further comprising: invoking one or more functions of the service in response to the client sending the first message to the service (column 6, lines 39-41).

Claims 4, 14, and 24

The method of claim 1, wherein the schema is expressed in a data representation language (column 5, lines 46-50).

Claims 5, 15, and 25

The method of claim 1, wherein the first message is expressed in a data representation language (column 5, lines 54-61 and column 6, lines 30-39).

Claims 7, 17, and 27

The method of claim 1, wherein the URI comprises an Internet address (column 4, lines 50-51).

Claims 8, 18, and 28

The method of claim 1, further comprising: the service publishing the advertisement in the space (column 4, lines 31-39).

Claims 9, 19, and 29

The method of claim 1, further comprising: the client using a lookup service to find the advertisement in the space (column 5, lines 65-67).

Claims 10, 20, and 30

Beck discloses the method of claim 1, further comprising: the client using the URI and the schema in the advertisement to construct a gate for access to the service (column 7, lines 34-44).

III. CLAIM REJECTIONS - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

A. Claims 6, 16, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beck in view of Official Notice.

Pursuant to the applicant's previous request for documentary evidence and MPEP 2144.03, the use of Official Notice was previously supported by and is herein supported by Roberts et al. (U.S. Patent Number 6,560,633), hereinafter referred to as Roberts, and thus the rejection has been previously and is now maintained.

Claims 6, 16, and 26

Beck discloses the method of claim 5, wherein the data representation language comprises extensible Markup Language (XML) (Roberts, column 4, line 50 through column 5, line 7).

As indicated in the foregoing mapping, Beck did not explicitly state a data representation language that comprises XML. However, Roberts does explicitly disclose this feature as his system is focused on generating and utilizing XML documents in order to implement web services on a network. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Beck by adding the ability to use a data representation language that comprises XML as provided by Roberts. Here the combination satisfies the need for a more efficient approach to service discovery that uses more efficient methods of describing and loading services. See Beck, column 1, lines 37-43.

IV. CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday to Friday [10 am - 6 pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu Nguyen can be reached on (571)272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOHM CHANKONG/
Primary Examiner, Art Unit 2452